

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
Filing Date: March 26, 2001
Page 5

REMARKS

Claims 1, 3-6 and 9 are pending in the instant application. Claims 1, 3-6 and 9 have been rejected. Claim 1 has been amended. Support for amendment to claim 1 is provided in the specification at page 18, line 20. Thus, no new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Information Disclosure Statement

References AB, AN and AP are not material to the patentability of the instant invention and need not be considered by the Examiner in this prosecution.

II. Rejection of Claim 1 under 35 U.S.C. § 112, second paragraph

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, has been maintained. The Examiner suggests that the phrase "hybridizing under stringent condition" is indefinite. While Applicants respectfully disagree with this suggestion, in an earnest effort to advance the prosecution of this case, this phrase has been deleted from the claim.

Withdrawal of this rejection is therefore respectfully requested.

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
Filing Date: March 26, 2001
Page 6

III. Rejection of Claims 1, 3-6 and 9 under 35 U.S.C. § 112,

first paragraph - Written Description

Claims 1, 3-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner suggests that the written description in this case only sets forth SEQ ID NO:8, a colon specific gene (CSG) and not a polynucleotide comprising a fragment of at least 15 contiguous nucleobases of SEQ ID NO:8 and the vector and host cell containing these polynucleotides and a method for producing the encoded polypeptide.

While Applicants respectfully disagree with the Examiner, in an earnest effort to advance the prosecution of this case, reference to fragments has been deleted from the claim.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

IV. Rejection of Claims 1,3-6 and 9 under 35 U.S.C. § 112, first paragraph

Claims 1, 3-6 and 9 have been rejected under 35 U.S.C. §

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
Filing Date: March 26, 2001
Page 7

112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the Examiner suggests that the claims encompass undefined polynucleotides comprising fragments of SEQ ID NO:8 as well as polynucleotides which hybridize under stringent conditions to an antisense sequence of SEQ ID NO:8. However, the Examiner suggests that neither the specification nor the Declaration by Dr. Macina provide support for use of polynucleotides comprising arbitrary 15 contiguous nucleobases of SEQ ID NO:8. The Examiner also suggests that any polynucleotide sequence that binds to the antisense of SEQ ID NO:8 would not necessarily be useful as a colon specific gene for diagnosing colon cancer.

Thus, in an earnest effort to advance the prosecution, but without conceding to any merit in the Examiner's position, Applicants have amended claim 1 to delete reference to fragments and polynucleotides that hybridize to the antisense of SEQ ID NO:8.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph is therefore respectfully requested.

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
Filing Date: March 26, 2001
Page 8

V. Rejection of Claim 1 under 35 U.S.C. § 102(b)

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Boehringer Mannheim Biochemicals 1991 Catalog, page 557. The Examiner suggests that this catalog discloses random primers that are hexanucleotides containing all possible 6-nucleotide sequences that would hybridize under stringent conditions to an antisense sequence of SEQ ID NO:8. As discussed in Section III and IV, supra, claim 1 has been amended and is no longer drawn to polynucleotides which hybridize under stringent conditions to the antisense of SEQ ID NO:8. Instead, the claims are now drawn to polynucleotides comprising SEQ ID NO:8 or nucleic acid sequences with at least 95% identity to SEQ ID NO:8. Support for this amendment is provided in the specification at page 18, line 20. Since the reference cited by the Examiner does not teach a polynucleotide comprising SEQ ID NO:8 nor a nucleic acid sequence with at least 95% identity to SEQ ID NO:8, this reference cannot anticipate the claim.

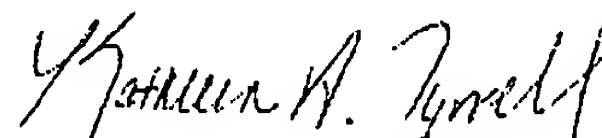
Withdrawal of this rejection under 35 U.S.C. § 102(b) is therefore respectfully requested.

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
Filing Date: March 26, 2001
Page 9

VI. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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